

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Gregory Winfield Gorman

Serial No.: 10/633,943

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For: INFORMATION-BEARING PAVEMENT TAPE

Group Art No.: 1772

Examiner: Nasser Ahmad

Confirmation No.: 5211

06 March 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT OF SUBSTANCE OF INTERVIEW

Dear Sir:

This Statement is filed responsive to the Interview Summary mailed 05 Feb. 2008.

On 30 Jan. 2008, the undersigned spoke with Examiner Nasser Ahmad regarding a communication mailed from the U.S. Patent Office on 08 Jan. 2008 (hereinafter, "the Communication"). The Communication stated that the reply brief filed 22 Oct. 2007 (hereinafter, "the Reply Brief") was considered non-compliant with 37 C.F.R. § 41.41(a), and thus would not be entered. The Examiner specified that "the Reply Brief appears to be directed to addressing claims that had been cancelled by the appellant and admitted in said reply brief. Further, appellant has re-iterated the arguments from the Appeal Brief of 5/2/2007." See the Communication at page 2, item number 1.

The undersigned pointed out that there is no prohibition against re-iterating appeal brief arguments in a reply brief, and further noted that, per MPEP §1208, it appears that Applicant has a responsibility to address each ground of rejection laid forth by the Examiner in an Examiner's Answer. As explained by the undersigned, the Examiner's Answer of 22 Aug. 2007 (hereinafter, "the Examiner's Answer") included rejections of previously cancelled claims, and hence, Applicant reiterated the same rejection headings, to make clear that all grounds of rejection were being addressed. However, the Reply Brief clearly stated that claims 12-19 were cancelled and therefore were not substantively argued in the Reply Brief.

Finally, the undersigned pointed out that the Examiner's Answer had indeed included a substantive rejection of claim 19. See the Examiner's Answer at page 5, second paragraph, and note that this rejection falls under a heading stating that "The following grounds of rejection are applicable to the appealed claims." See the Examiner's Answer at page 3, under item (9).

In response, Examiner Ahmad agreed that reiteration of appeal brief arguments in a reply brief was not grounds for finding the reply brief non-compliant. The Examiner stated that any substitute reply brief could include a reiteration of the appeal brief arguments.

Next, the Examiner explained that cancelled claims were included in his "Grounds for Rejection" because he had copied the rejections from a prior office action. The Examiner stated that when a rejection is copied from a prior action, the text of that rejection cannot be changed by the Examiner. No statutory basis for this statement was given. The undersigned explained that the Examiner put Applicant in an irresolvable position by presenting cancelled claims as (apparently) newly rejected, and then refusing to enter the Reply Brief when Applicant responded to the apparent "new" rejection as required per MPEP §1208(I)(B). In response, the Examiner stated that he would not enter the Reply Brief because the presence of cancelled claims in the subject headings (copied from the Examiner's Answer) would be 'too confusing for the Appeal Board'. However, the Examiner stated that a new reply brief could be filed.

The undersigned noted that the period for filing a reply brief had already passed, and that no provisions had been made for filing a substitute brief. The Examiner recognized that Applicant had no time remaining to file a new reply brief, and suggested that perhaps Applicant could petition for acceptance of a new brief. The undersigned informed the Examiner that Applicant would likely instead petition for acceptance of the Reply Brief of 22 Oct. 2007.


Conclusion

This Statement of Substance of Interview is timely filed within thirty days of the mailing date of the Examiner's Summary of Interview. Hence, this Statement should be entered in the file record for the instant application. No fees are believed due; however, if any fee is deemed necessary in connection with this Statement, Commissioner is hereby authorized to charge such fee to Deposit Account No. 12-0600.

Should any issue remain outstanding, the Examiner is encouraged to telephone the undersigned, or Appellant's representative, Curtis A. Vock, at (720) 931-3011.

Respectfully submitted,

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